DETAILED ACTION

Status of Claims

1. This action is a non-final, first office action in response to the application filed 6 July 2006.

2. Claims 1-13 are currently pending and have been examined.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on 13 October 2006 was filed before the mailing date of the first office action. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner, except where lined through. The Applicant has failed to provide the NPL Keba, "Kebox Solution Package." In addition, PG-Pub documents US-2002007281-A1 and US-2003226883-A1 fail to match any known documents in the PG-Pub database, and therefore will not be considered. The Examiner notes that the Applicant might have meant US-20020007281-A1 and US-20030226883-A1.

4. The information disclosure statement (IDS) submitted on 7 February 2007 was filed before the mailing date of the first office action. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Objections

5. Claims 8-13 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Currently, claims 8-13 depend from claim 7. Accordingly, the claims not been further treated on the merits.

6. With respect to claim 5, the Applicant states, "A method of implementing parcel-franking apparatus according to claim 1, said method comprising a franking operation..." The Applicant has failed to particularly define their invention because the Applicant has directed claim 5 to multiple statutory classes. An Applicant cannot claim "a method of implementing a system" as it fails to define which statutory class the Applicant is directing the claim to. The Applicant is directed toward MPEP 2173.05 (p) (II).

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 2 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. With respect to claim 2, the Applicant states, "...rates corresponding to various types of destination **and/or** to various types of shipping services, the management unit...." By stating **"and/or,"** the Applicant rendered this claim indefinite and unclear. It is unclear as to what exactly the Applicant is claiming, as "and/or" fails to particularly define the invention. The Applicant could be claiming the memory of the apparatus storing rates corresponding to either various types of destinations, to various types of shipping services, or to a combination of the two options. For the purpose of examination, the Examiner will interpret the claim to read, "...rates corresponding to various types of destination **or** to various types of shipping services, the management unit...."

10. With respect to claim 7, the Applicant states, "...with memory means (22) adapted to store tables of franking rates corresponding to different types of destination **and/or** to different types of shipping services, and wherein..." By stating **"and/or,"** the Applicant rendered this claim indefinite and unclear. It is unclear as to what exactly the Applicant is claiming, as "and/or" fails to particularly define the invention. The Applicant could be claiming the memory of the apparatus storing rates corresponding to either various types of destinations, to various types of shipping services, or to a combination of the two options. For the purpose of examination, the Examiner will interpret the claim to read, "...with memory means (22) adapted to store tables of franking rates corresponding to

different types of destination **or** to different types of shipping services, and wherein...."

Claim Rejections - 35 USC § 101

11. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. Claims 5-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

13. Based upon consideration of all of the relevant factors with respect to the claims as a whole, claims 5-7 are held to claim an abstract idea, and are therefore rejected as ineligible subject matter under 35 U.S.C § 101 (Bilski v. Kappos, 95 USPQ2d 1001 (U.S. 2010)). The rationale for this finding is explained below:

- Claim 5 states a method of implementing a parcel franking apparatus. This method appears to recite only a series of steps, that when performed complete the method; however claim 5 fails to recite a machine that when used performs a significant, non-post solution activity, nor does it recite a transformation of an article from one state or thing into another. Therefore claim 5 fails the machine or transformation test. In particular, claim 5 states, "...waiting for information indicating that the door of a determined locker is closed...computing a franking price...paying the franking price...locking the door..." These steps when performed, can be performed by mere mental steps or by the acts of a human being, and

therefore fail the machine-or-transformation test. The Examiner notes that if an apparatus were to perform the stated steps, the test would be passed. An example would be, "...waiting, **by a processor**, for information indicating that the door of a determined locker is closed...computing, **by the processor,** a franking price...**receiving payment, by the processor, of** the franking price...locking, **by the processor**, the door..."

- Claim 5 states a method of implementing a parcel franking apparatus. This method appears to be a mere statement of a general concept. In particular, the general concept is directed towards a series of mental steps and human actions. Therefore claim 5 merely cites an abstract idea, which is deemed non-statutory subject matter. In particular, the Examiner notes that the claim merely states waiting for information, computing a price, paying the computed price, and locking a door, which are all mental or basic physical steps performed by a human.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

17. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tateno et al. (US Patent 4836352) (hereinafter Tateno), in view of Moreno (US Patent 6882269 B2) (hereinafter Moreno).

18. With respect to claim 1, Tateno teaches:

- *A plurality of lockers (2) designed to contain parcels and each provided with a door (3)* (See at least column 3 lines 24-37 which describes a locker

with a plurality of boxes, wherein a package is placed in each box. In addition, column 3 lines 62-65 describe each box as having a locking door).

- *A management unit (11)* (See at least column 5 lines 21-35 which describe the use of a main controller).
- *Locks (4) each adapted to lock a respective door and each controlled individually by the management unit* (See at least column 3 lines 62-65 describe each box as having a locking door. In addition, see at least column 7 line 66 through column 8 line 28 which describes the main controller locking the door of the boxes).
- *Door position detectors (5), each associated with a respective door and adapted to inform the management unit when the corresponding door is closed* (See at least column 7 line 66 through column 8 line 28 which describes a door sensor that detects when the door is closed).
- *At least one weight sensor (9a, 9b) adapted to transmit to the management unit an indication of the weight of a parcel placed in one or other of the lockers* (See at least column 5 lines 21-35 and column 7 lines 24-36 which describe a weight sensor in the box that determines the weight of the package placed inside).
- *Display means (12), data input means (14), and payment means (16), all these means being connected to the management unit* (See at least column 7 lines 7-23 which describes a display screen, column 7 line 66

through column 8 line 48 which describe buttons that allow a user to select a destination for the package, and column 8 line 49-61 which describes a payment collection system for the locker system).

- *The management unit (11) is adapted: to compute a franking price for franking a parcel placed in a determined locker on the basis of the data delivered by the input means (14), and of the indication of the weight of said parcel as transmitted by the weight sensor (9a, 9b), when a position detector (5) associated with a door (3) of said determined locker (2) detects that the door is closed* (See at least column 7 line 66 through column 8 line 61 which describes determining a price for a package to be delivered based on the weight of the package and the destination of the package, wherein the price is determined once the door is closed).
- Locking the locker door (See at least column 7 line 66 through column 8 line 28 which describes locking the locker door when it is closed).
- Unlock the locker only upon receiving a command to do so (See at least column 10 lines 10-16 which describe a carrier unlocking the doors of the lockers using a key).

19. Tateno discloses all of the limitations of claim 1 as stated above. Tateno does not disclose the following, however Moreno teaches:

- *The management unit (11) is adapted: to cause the door of said locker to be locked once the computed franking price has been paid* (See at least

column 21 lines 17-27 and 57-67 which describe locking the locker once a package is placed in it and the payment is made).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the locker system that contains a series of lockable boxes, wherein a user places a package in the box, is charged for the weight of the package and the destination that the package is being shipped to, and a carrier picks up the package and delivers it of Tateno, with a locker system that allows a user to place objects for delivery in at least one of a plurality of boxes, wherein a user must pay for the delivery of the package before the at least one box is locked of Moreno. By waiting for the customer to pay for the delivery of the package, before locking the system, the system is reducing the steps it uses to complete its task. This will therefore reduce the energy used on automatically locking doors, therefore saving the owner's of the system money on infrastructure costs. In addition, locking the lockers at a later time would reduce the time period a user must wait in order to retrieve a package placed erroneously in a box, therefore increasing customer satisfaction with the system.

- *The management unit (11) is adapted: to keep the door of said locker locked until the management unit recognizes a parcel retrieval code which has been delivered to it by the data input means* (See at least column 15 lines 9-49 which describe a carrier opening a series of lockers by inputting an access code).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the locker system that contains a series of lockable boxes, wherein a user

places a package in the box, is charged for the weight of the package and the destination that the package is being shipped to, and a carrier picks up the package and delivers it of Tateno, with a locker system that allows a user to place objects for delivery in at least one of a plurality of boxes, wherein a user must pay for the delivery of the package before the at least one box is locked, and the at least one box is locked until the system retrieves an authorization code that unlocks the required doors of the at least one box of Moreno. By using an authorization code to unlock the boxes, instead of a key, a system would increase its security, as locks can be picked or broken into easily. In addition, an authorization code could be a unique code, which would identify the exact party that was opening the boxes, therefore further increasing the security of the locker system.

20. With respect to claim 2, the combination of Tateno and Moreno discloses all of the limitations of claim 1 as stated above. In addition, Tateno teaches:

- *Wherein the management unit (11) includes memory means (22) adapted to store tables of franking rates corresponding to various types of destinations and/or to various types of shipping services, the management unit being adapted to compute the franking price by means of a rate selected from the data delivered by the input means (14)* (See at least column 8 lines 29-48 which describe storing multiple rates in the memory of the system, wherein the rates correspond to the different regions a package can be delivered to).

21. With respect to claims 3/2/1 and 3/1, Tateno/Moreno discloses all of the limitations of claims 1 and 2 as stated above. In addition, Moreno teaches:

- *Wherein the management unit (11) includes memory means (23) adapted to store a plurality of predetermined shipping companies and a table associating a determined locker with a predefined shipping company, the management unit being adapted to record the association of a particular locker (2) with a predefined shipping company on the basis of the data delivered by the input means (14)* (See at least column 17 lines 3-62 which describe the locker system reserving a series of lockers for a specific carrier, such as UPS).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the locker system that contains a series of lockable boxes, wherein a user places a package in the box, is charged for the weight of the package and the destination that the package is being shipped to, and a carrier picks up the package and delivers it of Tateno, with a locker system that allows a user to place objects for delivery in at least one of a plurality of boxes, wherein a user must pay for the delivery of the package before the at least one box is locked, the at least one box is locked until the system retrieves an authorization code that unlocks the required doors of the at least one box, and the system containing in its memory a designation of a series of boxes for a specific user, such as a carrier of Moreno. By reserving specific boxes of the plurality of boxes in a locker system for a specific user, such as a carrier, a system can

guarantee a user that there will be enough boxes for their business. This would also allow the locker system to retrieve additional funds as a user would pay for the reserved boxes (Moreno column 17 lines 39-62).

22. With respect to claims 4/3/2/1 and 4/3/1, Tateno/Moreno discloses all of the limitations of claims 1, 2 and 3 as stated above. In addition, Moreno teaches:

- *Wherein the management unit (11) is adapted to cause the doors (3) of all of the lockers (2) associated with a predefined shipping company to be unlocked, once a retrieval code transmitted by the data input means (14) has been recognized* (See at least column 15 lines 9-49 which describe a carrier opening a series of lockers at once by inputting an access code).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the locker system that contains a series of lockable boxes, wherein a user places a package in the box, is charged for the weight of the package and the destination that the package is being shipped to, and a carrier picks up the package and delivers it of Tateno, with a locker system that allows a user to place objects for delivery in at least one of a plurality of boxes, wherein a user must pay for the delivery of the package before the at least one box is locked, and the at least one box is locked until the system retrieves an authorization code that unlocks the required doors of the at least one box of Moreno. By using an authorization code to unlock the boxes, instead of a key, a system would increase its security, as locks can be picked or broken into easily. In addition, an authorization code could be a unique code, which would identify

the exact party that was opening the boxes, therefore further increasing the security of the locker system. In addition, by opening a series of boxes at once using an access code, a user would be able to retrieve all of their packages in a single trip, therefore reducing the time needed to deal with the system.

23. With respect to claim 5, the combination of Tateno and Moreno discloses all of the limitations of claim 1 as stated above. In addition, Tateno teaches:

- *Waiting for information indicating that the door of a determined locker (2) is closed* (See at least column 7 line 66 through column 8 line 28 which describes a door sensor that detects when the door is closed).
- *Computing a franking price for franking a parcel placed in said determined locker on the basis of the data delivered to the input means (14) and by means of the indication of the weight of said parcel as transmitted by the weight sensor (9a, 9b)* (See at least column 7 line 66 through column 8 line 61 which describes determining a price for a package to be delivered based on the weight of the package and the destination of the package, wherein the price is determined once the door is closed).
- *Paying the franking price as previously computed* (See at least column 8 line 49 through column 9 line 15 which describes a user paying for the package placed in the box).

- *Locking the door of said determined locker* (See at least column 7 line 66 through column 8 line 28 which describes locking the locker door when it is closed).

24. With respect to claim 6, Tateno/Moreno discloses all of the limitations of claim 5 as stated above. In addition, Tateno teaches:

- *Wherein the franking operation further comprises, prior to the step of waiting for a closed signal: selecting the determined locker (2) from among the available lockers by the management unit (11); then unlocking the lock (4) of said determined locker by the management unit (11)* (See at least column 6 line 56 through column 23 which describes a user pressing a vacant green button in order to unlock an unused box in the locker system).

25. With respect to claims 7/6/5 and 7/5, Tateno/Moreno discloses all of the limitations of claim 5 as stated above. In addition, Tateno teaches:

- *Wherein the management unit (11) is provided with memory means (22) adapted to store tables of franking rates corresponding to different types of destination and/or to different types of shipping services, and wherein the computing step of the franking operation further comprises at least one of the following sub-steps: displaying various types of destination stored by the management unit, followed by using the input means (14) to select*

a type of destination, and applying the corresponding franking rate to computation of the franking price; and displaying various types of destination stored by the management unit, followed by using the input means (14) to select a type of shipping service and applying the corresponding franking rate to computation of the franking price (See at least column 8 lines 29-48 which describe storing multiple rates in the memory of the system, wherein the rates correspond to the different regions a package can be delivered to, and column 7 line 66 through column 8 line 28 which describe a user using input buttons to select a destination region of the package).

Conclusion

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Didriksen et al. (US 2001/0042055 A1) which describes a self service parcel system that a user uses to send a parcel to a desired location. The system uses a kiosk based system, wherein the user places the parcel to be delivered into a delivery window which uses a series of controls to place the parcel in a locker storage system in a secure area. When the package is to be delivered, a carrier retrieves the package from the locker system using the control system. In addition, the user pays for the

delivery using the kiosk before storing the package, wherein the price is based on the weight and destination of the package.

27. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Michael Harrington** whose telephone number is **571.270.1365.** The Examiner can normally be reached on Monday-Thursday, 8:00am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **John Hayes** can be reached at **571.272.6708**.

28. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://portal.uspto.gov/external/portal/pair . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

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Examiner

28 October 2010

Art Unit 3628

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